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10/614,589	07/07/2003	James C. Dow	10980475-5	7589

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EXAMINER

HERNANDEZ, NELSON D

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/614,589

Applicant(s)

DOW ET AL.

Examiner

Nelson D. Hernandez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/7/03, 8/15/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

1. The continuing data on page 1 should be updated to read "This application is a continuation of U.S. utility application entitled, "APPLIANCE AND METHOD FOR COMMUNICATING AND VIEWING MULTIPLE CAPTURED IMAGES," having Ser. No. 09/130,081, filed Aug. 7, 1998, now issued as U.S. Pat. No. 6,611,291 issued August 26, 2003, which claims priority to and is entirely incorporated herein by reference".

### *Claim Objections*

2. **Claim 9** is objected to because of the following informalities: in claim 9, "... comprising the step of displaying..." should be written as "... comprising a step of displaying ...". Appropriate correction is required.
3. **Claim 10** is objected to because of the following informalities: in claim 10, "... comprising the step of momentarily..." should be written as "... comprising a step of momentarily...". Appropriate correction is required.
4. **Claim 11** is objected to because of the following informalities: in claim 11, "... comprising the step of displaying..." should be written as "... comprising a step of displaying ...". Appropriate correction is required.
5. **Claim 12** is objected to because of the following informalities: in claim 12 "... comprising the step of momentarily..." should be written as "... comprising a step of momentarily...". Appropriate correction is required.

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6. **Claim 13** is objected to because of the following informalities: in claim 13 "... comprising the step of displaying..." should be written as "... comprising a step of displaying..." Appropriate correction is required.
7. **Claim 14** is objected to because of the following informalities: in claim 14 "... comprising the step of closing..." should be written as "... comprising a step of closing..." Appropriate correction is required.
8. **Claim 16** is objected to because of the following informalities: claim 16 is missing a punctuation period "." at the end of the claim. Appropriate correction is required.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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10. **Claim 1** is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,611,291 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because **claim 1** of the application recites:

a portable hand-held image capturing appliance, comprising:

a photoelement array for acquiring at least a first image data and a second image data (*claim 1 in Patent 6,611,291 B1 teaches the same*);

a processor configured to receive the first image data and the second image data from the photoelement, and configured to save the first image data and the second image data in an image group (*this is a broader recitation of "a memory for saving the image data" and "a processor in communication with said memory" as shown in claim 1 of Patent 6,611,291 B1*);

a display for displaying a page, the page corresponding to one of the first image data and the second image data in the image group (*this is a broader recitation of "a display in communication with said processor for exhibiting one of said image data" as shown in claim 1 of Patent 6,611,291 B1*); and

a program code executed by the processor for displaying the page, and for changing the displayed page from a current displayed page to a next displayed page, and for displaying a flipping animation between the current displayed page and the next displayed page (*this is a broader recitation of "program code stored in said memory and executed by said processor for viewing one of said image data, said program code comprising a page view software module for viewing said image data on said display of*

said appliance, and for displaying an animated sequence on said display after ending display of said first image data and before displaying said second image data, wherein said animated sequence is said first image data sliding off said display” as shown in claim 1 of Patent 6,611,291 B1). Claim 1 in the present application is different from claim 1 in Patent 6,611,291 B1 in that the application claims “displaying a flipping animation between the current displayed page and the next displayed page” and the Patent claims an animated sequence wherein said first image data sliding off said display. The Examiner understands that the flipping animation in the present application is a simple substitution of the sliding animation used in the Patent. Therefore, claim 1 in the application is encompassed with claim 1 in the Patent.

### ***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claim 19** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In line 1, is claimed “a computer-readable medium”. As disclosed in the (See pages 14 and 15, ¶ 0047), “a computer-readable can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific examples (a nonexhaustive

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list) of the computer-readable medium would include the following: an electrical connection (electronic) having one or more wires, a portable computer diskette (magnetic), a random access memory (RAM) (magnetic), a read-only memory (ROM) (magnetic), an erasable programmable read-only memory (EPROM or Flash memory) (magnetic), an optical fiber (optical), and a portable compact disc read-only memory (CDROM) (optical). Note that the computer-readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled, interpreted or otherwise processed in a suitable manner if necessary, and then stored in a computer memory 64." As disclosed in the specifications, the "computer-readable medium" is defined as a signal (an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium). A signal is not tangibly embodied.

Also claim 19 recites, "A computer-readable medium having a program for displaying image data, the program comprising logic configured to perform the steps of:" "A computer-readable medium having a program for displaying image data, the program comprising logic configured to perform the steps of:" as claimed does not define structural and functional interrelationships between the data structure and the computer software and hardware components, which permit the data structure's to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process; therefore the invention as claimed is non-statutory. For examining purposes, claim 19 will be read as "A

computer-readable medium having a program for displaying image data, the program comprising logic that when executed by an image capturing device would perform the steps of: ”.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 1-5, 8, 9, 11, 13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, US Patent 6,215,523 B1 in view of Ebihara, US Patent 5,231,512.**

**Regarding claim 1**, Anderson discloses a portable hand-held image capturing appliance (See fig. 5A), comprising: a photoelement array (Fig. 3: 114) for acquiring at least a first image data and a second image data; a processor (Fig. 3: 344) configured to receive the first image data and the second image data from the photoelement, and configured to save the first image data and the second image data in an image group (Anderson teaches grouping the images together to be viewed as a collection; col. 6, line 63 – col. 7, line 23); a display (Figs. 3: 402 and fig. 8: 402) for displaying a page, the page corresponding to one of the first image data and the second image data in the image group (See in fig. 8, the display 402 displaying a plurality of images organized as a film strip that allow the user to quickly move forward and backward among images;



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col. 10, lines 39-50; Anderson teaches organizing the stored images as a group for further display); and a program code (program used by the CPU 344 for controlling the display of the images; col. 4, lines 35-47; col. 5, lines 38-50; col. 10, lines 39-50) executed by the processor for displaying the page (See fig. 8), and for changing the displayed page from a current displayed page to a next displayed page (Using the navigation buttons 410), and for displaying a filmstrip animation between the current displayed page and the next displayed page (See figs. 8, 14A and 14B) (Col. 9, lines 24-64; col. 10, lines 39-67; col. 11, lines 1-9).

Although Anderson discloses applying a filmstrip animation effect to browse through images, Anderson does not explicitly disclose displaying a flipping animation between images.

However, Ebihara discloses an editing apparatus (Fig. 1) for applying special effects between consecutive image scenes, wherein said special effects includes a flipping animation (See figs. 5 and 6) (Col. 7, line 10 – col. 8, line 16).

Therefore, taking the combined teaching of Anderson in view of Ebihara as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson by displaying a flipping animation between images while being browsed. The motivation to do so would have been to provide an option of a more appealing video effect on the camera display while the user browse through the images in the group.

**Regarding claim 2**, limitations can be found in claim 1.

**Regarding claim 3**, limitations can be found in claim 1.

**Regarding claim 4**, the combined teaching of Anderson in view of Ebihara as applied to claim 1 teaches that the navigation button further comprises an left navigation button (See Anderson, fig. 10: 410a), wherein depression of the left navigation button causes display of another page corresponding to a previous image data in the image group (See Anderson, col. 10, lines 39-67). Although the button used in Anderson for displaying a previous image is the left navigation button and not an up navigation, one of ordinary skill in the art would find obvious at the time the invention was made to use an up navigation button instead of the left navigation button in Anderson as a simple matter of design choice since the navigation buttons would perform equally well with the motivation of having an alternative way of browsing through the images in the group.

**Regarding claim 5**, the combined teaching of Anderson in view of Ebihara as applied to claim 1 teaches that the navigation button further comprises a right navigation button (See Anderson, fig. 10: 410b), wherein depression of the right navigation button causes display of another page corresponding to a next image data in the image group (See Anderson, col. 10, lines 39-67). Although the button used in Anderson for displaying a next image is the right navigation button and not a down navigation, one of ordinary skill in the art would find obvious at the time the invention was made to use a down navigation button instead of the right navigation button in Anderson as a simple matter of design choice since the navigation buttons would perform equally well with the motivation of having an alternative way of browsing through the images in the group.

**Regarding claim 8**, claim 8 is a method claim for the apparatus in claim 1. The combined teaching of Anderson in view of Ebihara as discussed in claim 1 teaches the limitations in claim 8.

**Regarding claim 9**, limitations can be found in claims 1, 4 and 5.

**Regarding claim 11**, limitations can be found in claims 1, 4 and 5.

**Regarding claim 15**, claim 15 is claiming a system for the apparatus in claim 1. The combined teaching of Anderson in view of Ebihara as discussed in claim 1 teaches the limitations in claim 15.

**Regarding claim 16-18**, limitations can be found in claims 1, 4 and 5.

**Regarding claim 19**, claim 19 is claiming a computer-readable medium having a program for displaying image data, the program comprising logic that when executed by an image capturing device would perform the steps performed by the apparatus in claim 1. The combined teaching of Anderson in view of Ebihara as discussed in claim 1 teaches the limitations in claim 19.

**15. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, US Patent 6,215,523 B1 in view of Ebihara, US Patent 5,231,512 and further in view of Miller, US Patent 6,310,648 B1.**

**Regarding claim 7**, the combined teaching of Anderson in view of Ebihara teaches that the appliance is a camera (See Anderson, figs. 3 and 5A) but fails to teach that the appliance is a scanner.

However, Miller discloses a user interface for electronic viewing apparatus such as a camera (see fig. 1A) comprising a display (Fig. 1A: 35), wherein a set of captured images is displayed as a filmstrip in said display so that the user can browse through the images by using the navigation buttons (Figs. 2: 24 and 2: 26) (Col. 5, line 55 – col. 6, line 62). Miller also discloses that the user interface can be applied to a scanner (Col. 3, line 56 – col. 4, line 4).

Therefore, taking the combined teaching of Anderson in view of Ebihara and further in view of Miller as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson and Ebihara by having the interface being applied in a scanner. The motivation to do so would have been to improve the capabilities of a scanner by providing a presentation to the user of the scanned images while providing an easy to use interface to browse through the images as suggested by Miller (Col. 3, lines 4-17).

**16. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, US Patent 6,215,523 B1 in view of Ebihara, US Patent 5,231,512 and further in view of Kodama, US Patent 5,905,528.**

**Regarding claims 10 and 12,** the combined teaching of Anderson in view of Ebihara teaches displaying the page number of an image been viewed (See Anderson, fig. 8: 708) which is incremented in order of image number, date, time, etc. corresponding to the next image data but fails to teach displaying the group number with a page number.

However, displaying the group number (total number of images) along with the current page number viewed is known in the art as taught by Kodama. Kodama, discloses information in figs. 4B-4H displaying the total number of captured images or shots to the user (Col. 5, lines 54-62; col. 10, lines 49-59).

Therefore, taking the combined teaching of Anderson in view of Ebihara and further in view of Kodama as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson and Ebihara by displaying the group number (total number of images) along with the current page number. The motivation to do so would have been to easily identify the total number of images for each of the groups while browsing through images.

**17. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, US Patent 6,215,523 B1 in view of Ebihara, US Patent 5,231,512 and further in view of Anderson US Patent 6,249,316 B1.**

**Regarding claim 13**, the combined teaching of Anderson '523 in view of Ebihara fails to teach that the step of displaying the new page when a third navigation button is operated, the new page corresponding to a first image data in the contiguous members of the group.

However, Anderson '316 teaches a user interface to browse images in a camera comprising a 4-way navigation button (See fig. 4: 406) wherein the four keys of said 4-way navigation button are used to browse through the images so that when using any of

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the four buttons a new image can be displayed from the group of images (Col. 4, line 38 – col. 5, line 45).

Therefore, taking the combined teaching of Anderson '523 in view of Ebihara and further in view of Anderson '316 as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Anderson '523 and Ebihara by displaying the new page when a third navigation button is operated, the new page corresponding to a first image data in the contiguous members of the group. The motivation to do so would have been to ease the browse operation by skipping small groups of images to be viewed when having a large number of images in the group.

**Regarding claim 14**, the combined teaching of Anderson '523 in view of Ebihara and further in view of Anderson '316 teaches a step of closing display of the displayed page after the new page is displayed (See in Ebihara, fig. 6, after the current image is completely flipped the next one would be the only present in the display). Grounds for rejecting claim 1 apply here.

### ***Allowable Subject Matter***

18. **Claim 6** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. The following is a statement of reasons for the indication of allowable subject matter:

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**Regarding claim 6**, the main reason for indication of allowable subject matter is because the prior art fails to teach or reasonably suggest including the elements of the present claim, that wherein depression of the left navigation button, or wherein depression of the right navigation button, causes display of the flipping animation followed by display of a first page of the image group, and wherein the image group is automatically closed after display of the first page including all the limitations of claim 1.

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson D. Hernandez whose telephone number is (571) 272-7311. The examiner can normally be reached on 8:30 A.M. to 6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Nelson D. Hernandez  
Examiner  
Art Unit 2622

NDHH  
September 29, 2006

A handwritten signature in black ink, appearing to read 'Vivek Srivastava', with a stylized flourish at the end.

VIVEK SRIVASTAVA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600